

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Ims et al.
Serial No. : 09/754,891
Filed : January 5, 2001
Title : TECHNIQUE FOR AUTOMATED E-BUSINESS SERVICES
Attorney Docket : RSW920000077US1 (IBM010PA)
Examiner : Laurie Anne Ries
Art Unit : 2176

Mail Stop Appeal Brief--Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF

This Reply Brief is being filed responsive to the Examiner's Answer dated June 26, 2007.

I. Incorrect Claims Discussed in the Examiner's Answer

In the Examiner's Answer, the Examiner references and discusses an incorrect claim set not currently pending in the subject patent application.

As noted in applicants' Appeal Brief:

First and second Amendments After Final were filed respectively on October 4, 2006 and November 1, 2006. Those papers were not entered by the Primary Examiner. On December 12, 2006, applicants filed a "Petition to the Director of the USPTO from Refusal of the Primary Examiner to Enter an Amendment After Final Rejection and after the Filing of a Notice of Appeal." In the Amendment After Final dated November 1st, applicants deleted claims 3, 10 and 17 and added the limitations from those claims to independent claims 1, 8 and 15. Limitations similar to those added to claims 1, 8 and 15 were added to independent claim 22. Further, the language "configured for" was removed from claims 1, 2, 6 and 7. Supervisory Patent Examiner Heather R. Herndon indicated that the Amendment After Final Rejection dated November 1, 2006 changed the scope of the claims and, hence, would require further search and consideration. In a Decision on Petition for Supervisory Review under 37 CFR § 1.181 dated March 28, 2007, applicants petition requesting the Commissioner to invoke his

supervisory authority and enter the Amendment After Final Rejection which was refused entry was granted.

The Examiner's Answer addresses the claims set out in the Amendment dated May 5, 2006. The correct claims are those set out in the Amendment After Final Rejection dated November 1, 2006. Accordingly, the claims currently pending in the subject application have not been properly rejected.

2. Response to Examiner's Assertions Set Out on Pages 18 and 19 of the Examiner's Answer

A. The Examiner states on page 18:

ESpeak discloses in Appendix A, pages 71-76, that an XML document is received prior to starting the automated e-business service ***. Specifically, eSpeak discloses acquiring, or getting the XML document using a getXMLDocument utility procedure ***. The XML document is passed into the postRequest procedure as a String variable *** and is subsequently converted into a DOM document ***.

Initially, the "XML document" and the "getXMLDocument utility procedure" noted by the Examiner on page 18 of the Examiner's Answer do not comprise "a specification of an e-business service," as set out in independent claims 1, 8, 15, 22; "at least one e-business service definition document," as set out in claim 23; or "at least one application definition document," as set out in claims 25 and 27. Rather, the "XML document" noted on page 76 is merely a response document and the "getXMLDocument utility procedure" comprises a client application programming interface that encapsulates an HTTP request that returns an XML document.

It is also noted that the applications set out on pages 71-76 of the E'speak document comprise examples of Java applications for interacting with the E'speak application. None of these examples on pages 71-76 demonstrate implementations of E'speak services. Furthermore, the applications set out on pages 71-76 are written in Java programming language. More specifically, the applications are hard coded in java programming language. For example, on page 75 of E'speak, the "WebPCLookup.java" application performs the following three function

calls: do log in to get a session with e-speak; find service PC provider; and do log out, all of which are hard coded in java programming language, see lines 38-43 on page 75 of the E'speak document. Hence, the applications set out on pages 71-76 of the E'speak document do not comprise "a specification of an e-business service," as set out in independent claims 1, 8, 15, 22; "at least one e-business service definition document," as set out in claim 23; or "at least one application definition document," as set out in claims 25 and 27. Nor are the Java applications encoded in a structured markup language.

B. The Examiner states on page 19:

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., specifying in structured markup language syntax details of interactions to be carried out when operating an e-business service or an application described by a finite state machine) are not recited in the rejected claim(s). ***

This argument is set out in Applicants' Appeal Brief with regard to claims 23 and 25. It is respectfully submitted that claim 23 does recite specifying in structured markup language syntax details of interactions to be carried out when operating an e-business service and claim 25 does recite specifying in structured markup language syntax details of interactions to be carried out when operating an application described by a finite state machine.

CONCLUSION

It is submitted that claims 1, 2, 4, 5-9, 11-16, 18-28 and 30 define patentably over the applied prior art. Accordingly, it is respectfully requested that the Board reverse the Examiner's final rejection of claims 1, 2, 4, 5-9, 11-16, 18-28 and 30.

Respectfully submitted,
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